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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,465	03/26/2004	Sumihiro Miura	ASAM.0117	7641

7590

07/28/2005

REED SMITH LLP
Suite 1400
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Falls Church, VA 22042

EXAMINER

ELMORE, STEPHEN C

ART UNIT	PAPER NUMBER
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2186

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/809,465

Applicant(s)

MIURA, SUMIHIRO

Examiner

Stephen Elmore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 26, 2004 to date.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


STEPHEN C. ELMORE
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/26/04, 4/28/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 1-13 are presented for examination in response to this application and the approved Petition To Make Special filed April 28, 2005.

Drawings

2. The drawings are objected to because:

they contain elements which are described using non-idiomatic English language, i.e., non-standard technical terms, which language has not been expressly defined in the specification, or described by use of acronyms that have not been expressly identified in the specification, to describe technical features of the present invention, which usage of indefinite language makes the scope of the drawings unclear:

- a. Figure 1 - channel control portions, control terminal, internal connection portion, disk control portions;
- b. Figure 4 - control terminal, port;
- c. Figure 5 - channel control portion, interface portion;
- d. Figure 6 - disk control portion, interface portion;
- e. Figures 8 and 9 - channel control portion, internal connection portion, disk control portion, interface portion;
- f. Figures 10 and 16 - path side selector circuit, memory-side selector circuit, command/address analysis portion, erasing-strat address register, erasing-end address register, memory control portion;
- g. Figures 14 and 15 - acronyms LIDT, VIN;
- h. Figure 17 - channel control portion;
- i. Figure 18 - command/address analysis portion;
- j. Figure 19 - memory control portion;

Specification

3. The disclosure is objected to because:

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a. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The current title is not considered descriptive of the present invention because it fails to recite any novel aspect of the present invention to which the claims are directed;

b. The abstract of the disclosure is objected to because it contains non-idiomatic English in the use of the terminology and language - circuit board setting portion, circuit board is removably set, removal information output circuit;

c. the specification contains numerous instances of non-idiomatic English appearing to be a literal translation into English from a foreign document, the first instances are found at:

1. page 6, line 21 -- is constituted by;
2. page 7, lines 19 and 28 -- to constitute;
3. page 8, line 6 et seq. -- disk control portions, control terminal, internal connection portion, channel control portion;
4. page 8, line 28 -- perform various controls;
5. page 10, line 27 -- page 11, line 5 - this entire portion;
6. page 11, line 9 -- data...is exchanged;
7. page 11, lines 16-26 -- possible to use a configuration of indirectly executing...;

other instances of non-idiomatic English exist in the remainder of the specification, too numerous to specifically point out with causing an undue burden on the Office;

d. the Summary of the specification is objected to because it appears to be a copy of independent claim 1 and therefore fails to meet the requirements of a Summary of the present invention;

Correction is required. See MPEP § 608.01(b).

4. A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because the Specification, the Drawings and the Claims contain non-idiomatic English reflecting that these elements appear to be a literal translation into English from a foreign document in each of the particulars already noted above and as noted below.

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A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because:

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors which are identified as follows:

- a. Claim 1 -- circuit board setting portion to which the circuit board is removably set, circuit board setting portion, circuit board removal information;
- b. Claim 2 -- circuit board removal information, removal information output circuit;
- c. Claim 3 -- data erase circuit;
- d. Claim 4 -- to other data, data erase circuit;
- e. Claim 5 -- the other data, circuit board removal information, removal information output circuit;

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- f. Claim 6 -- data erase circuit, circuit board removal information, removal information output circuit;
- g. Claim 7 -- circuit board setting portion to which the circuit board is removably set, circuit board setting portion, circuit board removal information;
- h. Claim 8 -- circuit board removal information, removal information output circuit;
- i. Claim 10 -- to other data;
- j. Claim 11 -- the other data;
- k. Claim 13 -- channel control portion, request... is formed (appears twice), circuit board setting portion, are removably set, circuit board removal information, removal information output circuit, data erase circuit;
- l. Claims 9 and 12 inherit the deficiencies of the preceding claim in the claim dependency chain.

In re Steele

7. Claims 1-13 are therefore withdrawn from further consideration (e.g., such as under 35 USC §§ 102 or 103) because it is improper for the examiner to rely on speculative assumptions regarding the meaning of a claim or claims and then to base a rejection on these assumptions under 35 USC § 103. *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962).

The state of the disclosure, drawings and claims are such that it is not possible for the examiner to determine with any degree of specificity or distinctness the scope of coverage of these claims and limitations, to the extent that the examiner is uncertain as to what invention is presently being claimed in claims 1-13.

Additionally, where there is a great deal of confusion and uncertainty as to the proper interpretation of the limitations of a claim, it would not be proper to reject such a claim on the basis of prior art. In the present application there exists great uncertainty as to the proper interpretation of the limitations of these claims and even upon reading the specification, drawings, and claims taken as a whole, such reading does not permit one of ordinary skill in the art to comprehend the scope of

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coverage for these claims desired by the applicant due to the numerous problems in interpreting the meaning of the claims as noted above in the objections and rejections of the disclosure and claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Elmore whose telephone number is (571) 272-4436. The examiner can normally be reached on Mon-Fri from 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim can be reached on (571) 272-4182. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Stephen Elmore
Primary Examiner
Art Unit 2186

July 25, 2005